REMARKS

Claims 1-18 are all the claims pending in the application. By this Amendment, Applicant amends claim 13 to further clarify the invention. The amendment to claim 13 is clearly supported throughout the specification, *e.g.*, pages 10-11 of the specification. No new matter is being added.

Claim Rejections under 35 U.S.C. § 102

The Examiner maintained the rejection of claims 1-4, 6-10, and 12 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,208,988 to Schultz (hereinafter "Schultz"). In addition, the Examiner also rejected previously added claims 13-18 as being allegedly anticipated by Schultz. Applicant respectfully traverses this rejection and respectfully requests the Examiner to ***carefully reconsider*** this rejection in view of the following comments.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach ***every element and recitation of the Applicants' claims.*** Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

A. Claim 1

Independent claim 1 recites a number of unique features not found in the prior art. For example, claim 1 recites: *meta-data described by definitions that each publisher providing said electronic article defines differently... meta-data loading means for absorbing said different definitions and loading each of said meta-data.* For example, an illustrative, non-limiting

embodiment of the present invention discloses a single searching system for a plurality of electronic publishers. Each publisher has meta-data for each electronic article; however, there are no standards for defining meta-data. As a result, each publisher may define meta-data differently. For example, one publisher may provide an abstract for the article, another may skip it altogether, or one publisher may provide the article form and publication frequency, others may not. Similarly, one publisher may define a field of a meta-data to be the article's volume title, whereas another publisher may define this meta-data field an article's series title. An exemplary searching system absorbs all these different definitions of the meta-data and merges them into a single database, thereby, allowing the user to search for the needed article(s) without being conscious of these differences. This illustrative embodiment is provided by way of an example only and is not intended to limit the scope of the claims in any way.

Applicant has carefully restudied Schultz's discussion of the meta-data with metadata fields, which is not similar to the meta-data described by definition that each publisher providing said electronic article defines differently and loading means for absorbing said different definitions, as set forth in claim 1.

In response to Applicant's arguments submitted in the Amendment under 37 C.F.R. § 1.111 filed on June 22, 2004, the Examiner responds as follows:

> In response to applicant's argument that Schultz does not teach that *meta-data definitions are described different for each document record*, it is noted that Schultz teaches the method for identifying themes associated with a search query using metadata and for organizing documents responsive to the search query in accordance

> with the themes, *including loading meta-data for each of a plurality of articles, said meta-data is described by definitions that publishers provide to define said electronic articles by absorbing said different definitions*, wherein the meta-data fields in the document fields are associated with composite theme scores, each of which (scores) is compared to a threshold (C. 1, L 49-67; C. 3, L.30), thereby indicating said inventive feature" (page 6 of the Office Action), ***italics represent Examiner's paraphrasing of the claim language.***

With respect to the above cited paragraph, however, Applicant respectfully points out that claim 1 recites: "*meta-data described by definitions that each publisher providing said electronic article defines differently.*" In other words, meta-data definitions differ from publisher to publisher as is clear from the claim. Applicant respectfully points out that in rebutting Applicant's arguments, the Examiner failed to indicate and/or to explain how Schultz discloses definitions of the meta-data defined differently by various publishers.

For support, the Examiner cited col. 1, lines 49 to 67 (see pages 2 and 6 of the Office Action). Col. 1, lines 49 to 67 recites:

> A document record archive has a plurality of document records each of which is associated with a stored document. Each of the document records has a plurality of metadata fields each of which stores a numerical score representing a degree of correlation between the stored document associated with the document record and a document theme, wherein the document theme corresponds to a subject, person or place associated with the stored document. A results list is retrieved in response to the search query, the results list is formed of document records each of which is associated with the search query. A composite theme score is determined for each document theme represented by the metadata fields in the

> document records in the results list. Each of the plurality of composite theme scores is compared to a threshold. Each composite theme score that exceeds the threshold is identified as a major theme score, and the document theme associated with the major theme score is selected as a query theme associated with the search query, emphasis added.

However, in this passage, there is no mention of a publisher. Moreover, there is no indication that meta-data definitions are described differently for some records as opposed to other records. In fact, this passage suggests just the opposite. Each document record has a plurality of metadata fields, each of which stores a numerical value representing correlation between the document and a theme. The theme can be a subject, person or a place. In short, this passage fails to disclose meta-data definitions being described differently by various publishers.

Next, col. 3, lines 27 to 30 recite:

> "data center 110 also includes a library database 118 for storing text, image, audio or other multi-media information representative of files provided by a plurality of publishers 112."

The above noted sentence teaches that the library database has information (text, image, audio, etc.) from a plurality of publishers. The above noted paragraph, however, does not teach or suggest anything above the meta-data or the meta-data fields. In fact, as is evident from Fig. 1; col. 2, lines 57 to 60, the library includes articles, images, etc. (the information the user searches for) from a number of publishers. In particular, col. 2, lines 57 to 60 recite:

> The information retrieval system 100 includes a user station 102 for searching information files which have been collected from various publisher sources 112 and stored in data center 110.

In other words, Schultz only teaches that multi-media information is collected from various publishers (the articles, images, etc.) but it fails to teach or suggest collecting meta-data from various publishers, let alone the definitions of the meta-data from various publishers. In short, as is evident from the above-cited passages, Schultz only teaches gathering multi-media information from various publishers and is not related to meta-data definitions being defined different by various publishers.

In fact, Schultz addresses a completely different problem. In particular, Schultz teaches that the conventional searching/retrieval systems are not adapted to identify the best or most relevant information yielding by the query search (col. 1, lines 32 to 35). Therefore, Schultz teaches identifying a query theme which corresponds to a person, place, or subject and having a document record with a number of metadata fields for each stored document (the multi-media information). The value for the metadata field is a score representing the degree of correlation between the stored documents and a document theme. Consequently, Schultz teaches that using these scores, the data can be sorted based on relevance of the information to the search query (col. 1, lines 49 to 57).

In other words, Schultz simply collects the multi-media information from various publishers and creates data records for each multi-media item. For example, Schultz teaches that an individual data record is formed of a header 400a, and metadata fields 400b, 400c, and 400d. Metadata field 400b stores a numerical score (value or meta-data) representing the degree of correlation between the stored document associated with the document record and a particular subject (*e.g.* sports, politics, entertainment, etc.). Metadata field 400c stores a numerical score (a

count) representing a number of times a given person is mentioned in a document and metadata field 400d stores a numerical score (a count) representing a number of times a given place is mentioned in the document record. Thus, the more often a person or place is mentioned in the document, the higher the count will be (col. 11, line 40 to col. 12, line 18). That is, Schultz creates a document record with the meta-data fields being <subject>, <person>, <location> (400b, 400c and 400d).

In short, Schultz is not related to the meta-data definitions defined by the publishers. In fact, the only meta-data being taught by Schultz is the meta-data created in the generated data record. Moreover, Schultz fails to even mention that one record may have metadata definitions <theme> <name> <place> and another record would have metadata definitions <subject> <person> <location>. In fact, this would not happen, since the metadata definitions are created by the theme identifying system of Schultz.

To sum up, Schultz teaches obtaining multi-media information from a number of publishers and placing this information into a library database for access by the user. Then, creating a record for each item in the library database, where such record will contain metadata for the metadata fields predefined by <subject>, <person>, <location>. Schultz does not unequivocally disclose having meta-data field being defined differently by various publishers. Moreover, as explained above, in Schultz only the multi-media information is loaded from each publisher and not the meta-data from each publisher. Schultz creates its own meta-data using the metadata fields created by the Schultz's theme identifying system.

Therefore, "meta-data described by definitions that each publisher providing said electronic article defines differently.....meta-data loading means for absorbing said different definitions and loading each of said meta-data," as set forth in claim 1 is not disclosed by (and is not obvious over) Schultz, which lacks any mention of the meta-data definitions being defined differently by each publisher and loading the meta-data from each publisher. For at least these exemplary reasons, Applicant respectfully submits that independent claim 1 is patentably distinguishable from Schultz. Applicant therefore respectfully requests the Examiner to reconsider and to withdraw this rejection of independent claims 1.

B. Claims 2-4 and 6

Applicant respectfully submits that claims 2-4 and 6 are allowable at least by virtue of their dependency on claim 1.

C. Claims 7-10 and 12-18

Next, Applicant respectfully traverses this rejection with respect to independent claims 7 and 13, which recite similar features to the features argued above with respect to claim 1. Since claims 7 and 13 contain features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially the same exemplary reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claims 7 and 13 and their dependent claims 8-10, 12, and 14-18, respectively.

Moreover, independent claim 13 recites:

loading meta-data for each of a plurality of articles, wherein said plurality of articles are from different publishers and wherein a pulisher from said different publishers describes definitions for meta-data of an article from said plurality of articles differently from another publisher from said different publishers;

interpreting the differences in said definitions for the meta-data;

merging said loaded meta-data into a database; searching through said merged meta-data based on a query from said subscriber; and

obtaining said electronic article based on link information indicated by said meta-data.

The Examiner simply rejected this claims for the same reasons as claims 1 and 7 (see page 2 of the Office Action). Applicant respectfully points out, however, that claim 13, among a number of unique features requires merging the loaded meta-data into a database and searching through said merged meta-data based on a query from said subscriber. Schultz only teaches loading the multi-media information and creating the metadata for each loaded item. In short, Schultz fails to teach or suggest not only loading the meta-data, which is defined differently by various publishers but also Schultz fails to teach or suggest merging the loaded meta-data. Moreover, claim 13, as now amended, recites: "interpreting the differences in said definitions for the meta-data." Schultz fails to teach or suggest interpreting differences in the definitions of the metas-data. For at least this addition reason, Applicant respectfully requests the Examiner to withdraw this rejection of claim 13.

Next, instead of considering the recitations of the newly added claims 14-18, the Examiner turned to MPEP § 2106, Section VI alleging that the subject matter of the newly added claims is nonfunctional descriptive material (see page 3 of the Office Action). Applicant respectfully submits that there is no support for the Examiner's assertion that such a limitation cannot patentably distinguish a claim from the prior art.

In support of his assertion, the Examiner cites *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983) and *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir.1999). First, Applicant respectfully points out that *In re Dembiczak* stands for the proposition that "a rejection of the claim as a whole under 35 U.S.C. § 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art," see MPEP § 2106, § VI.[1] Clearly, this case is inapplicable.

Next, *In re Gulack* relates to patent application rejected by the Board under the "printed matter rejection." However, the Examiner fails to recognize that the *In re Gulack* court stated that:

> [d]ifferences between an invention and the prior art cited against it cannot be ignored

[1] In particular, in *In re Dembiczak*, the patent appeals board (board) sustained and rejected all pending claims to appellants' claims in their patent application for a large trash bag made of orange plastic that when filled with trash or leaves would resemble a Halloween-style pumpkin, or jack-o'-lantern. Appellants challenged the board decision in the federal courts contending error in rejection of their pending claims and for obviousness-type double patenting. The court found no evidence in the record of a suggestion, teaching, or motivation to combine the prior art references asserted against the pending claims and reversed obviousness rejections. Concluding that there was no prima facie case against appellants, the court reversed the board's sustainment of their pending claims. The court further found, after de novo review, that the board had misapprehended the test for obviousness-type double patenting. Because the pending utility claims did not render obvious the design patents, the double patenting rejections were also improperly denied. The court reversed as to the double patenting rejections. The board decisions against appellant patent applicants were reversed.

> merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.

In fact, *In re Gulack* court found that the digits of Gulack's invention are functionally related to the band, and reversed the Board, *Id.* at 703 F.2d 1386.[2] Therefore, it is clear that the Examiner has misapplied the *In re Dembiczak* and *In re Gulack* cases, and that the asserted printed matter rejection is not applicable to the above-noted features of claims 14-18.

Moreover, the Examiner alleges that how the publisher provides the meta-data definitions is irrelevant to the function performed in Schultz (page 3 of the Office Action). Applicant respectfully submits that, indeed, meta-data definitions defined by various publishers are irrelevant to the teachings in Schultz, since Shultz clearly fails to address meta-data and meta-data definitions from various publishers, as explained in greater detail herein above.

Applicant respectfully points out that the proper analysis is whether the features of claims 14-18 functionally relate to the recitation of claim 13 on which they depend. MPEP § 2106, Section VI states that:

[2] In particular, in *In re Gulack*, inventor filed a patent application. The stated object of the disclosed invention was to exploit certain arithmetic properties to create the semblance of magic or to educate with respect to intriguing aspects of number theory. The patent examiner rejected certain claims of inventor's application on grounds that the claims were not directed to statutory subject matter, pursuant to 35 U.S.C. § 101 and the claims were unpatentable over prior art, pursuant to 35 U.S.C. § 103. The U.S. Patent and Trademark Office Board of Appeals reversed the examiner's § 101 rejection, but affirmed the § 103 rejection. On appeal, the court reversed. The appealed claims were not obvious under 35 U.S.C. § 103 in view of the prior art. Moreover, the board incorrectly declined to accord printed matter contained in the invention patentable weight.

> Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described *supra* in paragraphs IV.B.1(a) and IV. B.1(b).

In particular, in MPEP § 2106, Section IV.B.1(b), it is stated that:

> Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of non-statutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process, emphasis added.

Therefore, in determining whether claims 14-18 recite functional descriptive material, these dependent claims must be analyzed in light of the independent claim 13 from which they depend.

For example, claim 14 recites: "said publisher of said article describes a definition of a field of said loaded meta-data for said article diffrently from said another publisher," and independent claim 13 recites "searching through said merged meta-data." Clearly, when definitions of the loaded meta-data vary from publisher to publisher, it will impact the searching through said merged meta-data. That is, how the definitional fields of the meta-dat are defined

alters the searching of the meta-data. In other words, there is a functional interrelationship between the searching of the meta-data as recited in claim 13 and the definitions for the meta-data as recited in claim 14.

To illustrate a functional interrelationship that exists between the definitions of the meta-data and seacrhing of the meta-data, Applicant describes the following example. This example is provided for an explanation only and is not intended to limit the scope of the claims in any way. For example, the user enters a search query, "title: War and Peace." When the meta-data fields are defined differently by various publishers, *e.g.*, one publisher defines the meta-data "War and Peace" as the "title", another as "name", yet another may define it as "heading," the searching for the book will be significantly more difficult because the search engine must recognize that these various definitions identify the same meta-data. Consequently, the process for searching for the book will be more complex. In short, this is one example of how an interrelationship exists between searching and defintions of the meta-data.

Moreover, as now amended, claim 13 recites: "interpreting the differences in said definitions for the meta-data." Clearly, there is a functional interrelationship between interpretting definitions and variations in the definitions. For at least these exemplary reasons, claims 14-18 are interrelated to the functional recitations of the independent claim 13 and should be considered on their merits.

Claim Rejections under 35 U.S.C. § 103

Claims 5 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of U.S. Patent No. 6,272,484 to Martin et al. (hereinafter "Martin"). Applicant

respectfully traverses this rejection with respect to the dependent upon claim 1, claim 5 and dependent upon claim 7, claim 11. Applicant has already demonstrated that Schultz does not meet all the requirements of independent claim 1. Martin is relied upon only for its teaching of SGML and XML (see page 4 of the Office Action). Clearly, Martin fails to cure the deficient teachings of Schultz.

Moreover, one of ordinary skill in the art confronted with the problem of creating a system for effective and most productive searches would never have turned to the reference such as Martin. Martin teaches an information exchange system (saving the viewed webpage at a particular point in time and being able to send this saved web page to another user). Martin is not related to searches.

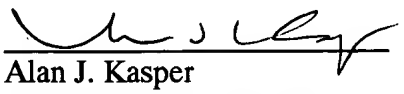
In short, Martin does not compensate for the above-identified deficiencies of Schultz, and one of ordinary skill in the art would not have been motivated to combine the two references in the manner suggested by the Examiner. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1 or claim 7. Since claim 5 depends on claim 1 and claim 11 depends on claim 7, they may be patentable at least by virtue of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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